

## REMARKS

This amendment is filed in response to the Office Action dated November 2, 2005, pursuant to 37 C.F.R. § 1.116. In view of these amendment and remarks, this amendment should be entered, the application allowed, and the case passed to issue.

No new matter or considerations are introduced by this amendment. The amendment to claim 1 is supported by claims 8, 9, 13, 17, and 19. Support for the amendment to claim 26 is found in claim 24. Claims 10 and 15 are amended maintain proper dependency. The amendment to the specification corrects an informality.

No new considerations are raised, as claim 1 has been amended to include limitations of claims 8, 9, 13, 17, and 19, all of which were previously considered by the Examiner. Claim 24, which was previously considered and allowed, provides the support for the amendment to claim 26.

Claims 1-7, 10-12, 15, 16, and 21-26 are pending in this application. Claims 12, 16, 18, 20, and 22 were withdrawn pursuant to a restriction requirement. Claims 1-11, 13-15, 17, 19, 21, 23, and 26 are rejected. Claims 24 and 25 are allowed. Claims 1, 10, 15, and 26 have been amended in this response. Claims 8, 9, 13, 14, and 17-20 have been canceled in this response.

### *Allowable Subject Matter*

Claims 24 and 25 were allowed. Applicants gratefully acknowledged the indication of allowed claims.

### *Claim Rejections Under 35 U. S. C. § 103*

Claims 1-11, 13-15, 17, 19, 21, 23, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakata et al. (U.S. Pub. Pat. App. No. 2002/0094458). This rejection is

traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the invention as claimed and the cited prior art.

Nakata et al. do not suggest the claimed method, as Nakata et al. do not suggest forming any of the magnetic recording layers recited in claim 1. Nakata et al. do not suggest forming a Co-based alloy, Cr-rich grain boundary type magnetic alloy comprising a CoCrPtX alloy, a granular type magnetic recording layer comprising a CoPtX alloy, a superlattice-type magnetic recording layer comprising a multi-layer  $(\text{CoX/Pd})_n$  or  $(\text{CoX/Pt})_n$  structure, or a  $L1_0$  ferromagnetic metal alloy type layer comprising a FePt or CoPt alloy, as required by claim 1. Each of these magnetic recording layers were claimed in claims 9, 13, 17, or 19. Though, the Examiner rejected claims 9, 13, 17, and 19, thus asserting that the claimed method including the steps of forming the magnetic recording layers of claims 9, 13, 17, and 19 was obvious, the Examiner did not explain where Nakata et al. suggests forming the claimed magnetic recording layer. Furthermore, the Office Action makes no mention of the specific magnetic recording layers of claims 9, 13, 17, and 19.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). There is no suggestion in Nakata et al. to modify the method of Nakata et al. to form any of the magnetic recording layers required by claim 1.

The requisite motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103 is not an abstract concept, but must stem from the applied prior art as a whole and realistically impel one having ordinary skill in the art to modify a specific reference in a specific manner to arrive at a specifically claimed invention. *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989).

Accordingly, the Examiner is charged with the initial burden of identifying a source in the applied prior art for the requisite realistic motivation. *Smiths Industries Medical System v. Vital Signs, Inc.*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999); *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1449 (Fed. Cir. 1997). There is no motivation in Nakata et al. to modify the method of Nakata et al. to form any of the magnetic recording layers required by claim 1.

In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to discharge the initial burden by, *inter alia*, making "**clear and particular**" factual findings as to a **specific understanding** or **specific technological principle** which would have **realistically** impelled one having ordinary skill in the art to modify an applied reference to arrive at the claimed invention based upon facts, -- not generalizations. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 57 USPQ2d 1161 (Fed. Cir. 2000); *Ecolochem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab, supra*; *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). That burden has not been discharged, as the Examiner has provided no factual basis for modifying the method of Nakata et al. to form any of the magnetic recording layers required by claim 1.

The only teaching of the claimed method of manufacturing a magnetic recording medium comprising forming any of the specified magnetic recording layers is found in Applicants' disclosure. However, the teaching or suggestion to make a claimed combination and the

reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner's retrospective assessment of the claimed invention and use of unsupported conclusory statements are not legally sufficient to generate a case of *prima facie* obviousness. The motivation for modifying the prior art must come from the prior art and must be based on facts. The Examiner is not free to ignore the judicial requirement for **facts**. To do so is legal error. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is apparent that the Examiner has relied on improper hindsight rejection in reaching the conclusion of obviousness.

The dependent claims are allowable for at least the same reasons as independent claim 1 and further distinguish the claimed invention.

Amended claim 26 is not suggested by Nakata et al. Nakata et al. do not suggest the claimed method of manufacturing a magnetic recording medium, wherein the substrate is transported between and through each of the first, second, and third portions at a substantially constant rate.

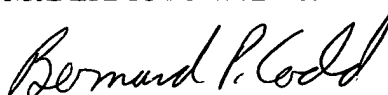
In view of the above amendments and remarks, Applicants submit that this amendment should be entered, the case allowed, and passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

10/663,698

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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